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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,594	05/25/2000	Haruyasu Ueda	826.1606/JDH	7152

21171 7590 10/20/2003

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EXAMINER

ENG, DAVID Y

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 10/20/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/577,594

Applicant(s)

UEDA, HARUYASU

Examiner

DAVID Y. ENG

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/4/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 4-8, 12-16 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9-11 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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In response to the Examiner's request to submit a copy of the Costales et al. reference, Applicants submit on 8/4/2003 an Amazon.com web page instead. There is no copy of Costales et al. submitted to the Examiner. It is not seen how the web page is related to the instant invention. Applicants are requested to submit to the Examiner information on the relevance of the cited web page with respect to the claimed invention under 37 CFR 105. The web page will not be made of record until Applicants clarify whether the web page or the Costales et al. reference Applicants wish the Examiner to consider.

In the communication filed on 8/4/2003, Applicants requested to have the Costales et al. reference considered. Since Applicants fail to provide a copy thereof to the Examiner, the reference has not been considered.

Applicants' explanation of the invention on page 6-7 of the communication is not understood. No blocking of junk email is seen in the explanation.

On page 2 of the communication, Applicants stated that new claims 19-20 are added. However, there are no new claims 19-20 submitted in the communication. The active claims are therefore 1-3, 9-11 and 17. Claims 4-8, 12-16 and 18 have been withdrawn from consideration as non-elected claims.

Claims 1-3, 9-11 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what the extracted (from the received email) mail address is destining. The terms "the mail address of the received email" and "a mail address

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indicating a destination" are vague and indefinite. It is not clear what those addresses are addressing. It is not seen how those addresses are related to blocking of junk email.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 9-11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirch (USP 6,546,416) in view of Milloslavsky (USP 5,765,033).

Details of the rejection have already been set forth in the last Office action. The details are incorporated herein by reference thereto.

In the remarks directed to the 103 rejection, filed on 8/4/2003, Applicants' only comment, in one single sentence, on Kirsch is that "kirsch only uses the origin or source address of e-mail in determining how the e-mail will be handled". No further comment is made as to how that will make the claims patentably distinct over Kirsch. Note that the claims fail to recite sender/receiver or source/destination. Note further that the claims fail to make clear whether the junk mailer is the sender or the receiver of the mail recited in the claims. Further note that the matching step is to identify the junk mailer from the other e-mailer. The matching step therefore is to compare "return address" (address of sender) to "black list addresses" (known junk mailers) stored in a storing unit. Obviously, junk mails can not be identified by comparing address of junk mail recipient with the black list.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



DAVID Y. ENG
PRIMARY EXAMINER